

REMARKS

Favorable reconsideration and allowance of the claims of the present application, as amended herein, are respectfully requested.

In the present Office Action, Claims 1-10 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 4,443,497 to Samejima et al. ("the '497 patent") in view of Japanese Patent Application JP 07096166 A ("the '166 patent application"). Applicants observe that the Examiner inadvertently described the '497 patent as U.S. Patent No. 4,443,479 in the present Office Action. See page 2, the second last paragraph of the present Office Action.

With respect to the above-mentioned § 103 rejection, applicants have amended the claims in a manner as indicated in the above. Specifically, applicants have amended Claim 1 by adding a limitation of an acidic pH range of skin above 5.0. Applicants have also amended Claim 10 to provide a pH range consistent with amended Claim 1. Support for the above-mentioned amendment to the claims is found at page 1, paragraph [0001]; page 5, paragraphs [0026] and [0027]; page 7, paragraph [0037] and page 9, paragraph [0048]. Since the above-described amendment to the claims is fully supported by the originally filed application, entry thereof is respectfully requested.

In view of the above-mentioned amendment, applicants submit that the claims of the present invention are not rendered unpatentable by the disclosure of the '497 patent in view of the '166 patent application since the applied references, either solely or combined, fail to teach or suggest the cosmetic preparation as claimed in the present invention.

Regarding the primary reference, the '497 patent, applicants submit that there are several differences between the cosmetic preparation claimed in the present invention and

microcapsules disclosed in the '497 patent. Specifically, the copolymers disclosed in the '497 patent which are used to encapsulate the microcapsules are soluble at a pH not higher than 5. See column 2, lines 45-55. In contrast, in the present invention, the encapsulating copolymers are soluble, swellable, and permeable above a pH of 5. See Page 9, paragraph [0048].

Therefore, the '497 patent not only fails to disclose the pH limitation, but even teaches away from the present invention. Moreover, the present invention is a cosmetic preparation which is applied in the treatment of skin. See page 7, paragraph [0037]. On the contrary, the microcapsules disclosed in the '497 patent are used to encapsulate pharmaceutical active compounds to be soluble in gastro-intestinal tracts. See column 1, lines 4-7. It is to be noted that the effectiveness of the release of cosmetic active ingredients from the encapsulating copolymers not only depends on the chemical composition of such copolymers, but also directly relates to the composition of the active ingredients being encapsulated and the releasing environment. If the material being encapsulated and the releasing environment is different from one art to another, one would be unable to utilize the same methodology as in the prior art to effect the intended treatment in skin. In other words, the type of methodology utilized is dependent upon each set of circumstances and cannot be generalized. Applicants draw the Examiner's attention to the fact that the pharmaceutically active compound disclosed in the primary reference is different from the cosmetic active ingredients recited in the present invention; and the physiological and chemical environment of the skin is different to that of the gastro-intestinal tracts disclosed in the primary reference. Therefore, applicants submit that there is no teaching or suggestion from the primary reference that the copolymers of the prior art can be used in the present invention with reasonable expectation to be successful.

Furthermore, it is to be noted that the primary reference provides that ethylcellulose is a

required material, other than the copolymers, in the preparation of the microcapsules. See the Abstract. However, this is not the case in the present invention.

In view of the above remarks, applicants submit that the cosmetic preparation claimed in the present invention is not obvious to one of the skilled in the art from the teaching of the '497 patent.

With respect to the secondary reference, the '166 patent application, it discloses a cosmetic preparation wherein porous fine particles, other than copolymers, are required in the preparation of the microcapsules. See page 2, paragraph [0009], [0012]; and page 3, paragraph [0023]. Therefore, the secondary applied reference teaches away from the present invention because the microcapsules recited in the present invention are free from porous materials. See page 1, paragraph [0001]. Furthermore, applicants in the present invention find a surprising result of the non-use of porous material over the '166 patent application. The cosmetics claimed in the present invention provide easier and more pleasant cosmetic application on the skin because the use of porous material adds an unpleasant feeling to dermatological preparations as the material stays on the skin and does not dissolve. See page 8, paragraph [0040] to [0042]. Therefore, this unexpected and superior result rebuts any allegation of prima facie obviousness.

Furthermore, as discussed in the above, applicants submit that a person skilled in the art would not combine the primary and secondary references in the first instance because the primary reference is related to a microcapsule containing pharmaceutical active compound which is intended to be soluble in gastro-intestinal tracts, whereas the secondary reference is concerned a microcapsule containing cosmetic ingredients to be applied on the skin. Moreover, even combined, the references at most teach that a microcapsule is prepared under

the presence of ethylcellulose, such microcapsule contains a porous material, and the microcapsule is soluble at a pH not higher than 5. Such teaching is completely different to the subject matter claimed in the present invention, and it clearly teaches away from the present invention for the reasons discussed in the above. Last but not least, even if the disclosures of the cited references present a prima facie case of obviousness, that case can be rebutted by a showing of unexpected results as demonstrated in the present invention. Thus, the conclusion is compelling that the present invention is not obvious over the applied references.

The rejection under 35 U.S.C. §103 has been obviated; therefore reconsideration and withdrawal thereof are respectfully requested.

Thus, in view of the foregoing amendments and remarks, it is firmly believed that the present case is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'LSZ', with a long horizontal stroke extending to the right.

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